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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/732,726

12/10/2003

William T. Ball

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EXAMINER

FETSUGA, ROBERT M

ART UNIT

PAPER NUMBER

3751

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/732,726	<b>Applicant(s)</b> BALL, WILLIAM T.	
	<b>Examiner</b> Robert M. Fetsuga	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 11, 2009 has been entered. The arguments filed with the request on April 05, 2010 are also acknowledged.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-23, 11, 12 and 14 are rejected under 35 U.S.C.

103(a) as being unpatentable over CH 346187 and Fritz et al.

'531. Fritz et al. '531 (Fritz) qualifies as prior art under Statute 102(e).

The CH 346187 (Gebert) reference discloses an overflow assembly comprising (using claim 21 nomenclature): an overflow pipe 1 including an upper end (at 4) and a lower end 2; an elbow 3; a lip 5; a nut element 8 including a radially extending lug 11; a bathtub including a wall 7; and a cap 14. Gebert also contemplates, as found in the second full paragraph on page 4 of the English language translation, that a retaining ring 10 (which exhibits the noted lug 11) could include notches to receive inner projections of the cap 14. The presence of these notches would define "a plurality of lugs" therebetween, as recited in claim 21. Therefore, Gebert teaches all elements set forth in claims 21, 22, 11 and 12 except for the provision of fluid flow preventing means.

Although the upper end of the Gebert overflow assembly does not include fluid flow preventing means, as claimed, attention is directed to the Fritz reference which discloses an analogous

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overflow assembly which further includes an upper end 21 having fluid flow preventing means in the form of a diaphragm 15/76.

Therefore, in consideration of Fritz, it would have been obvious to one of ordinary skill in the overflow assembly art to associate a diaphragm with the upper end of Gebert in order to facilitate hydraulic testing (col. 1 lns. 49-52). Re claim 22, the diaphragm taught by Fritz is removable (col. 4 lns. 38-41).

Re claim 23, although the upper end of the Gebert overflow assembly does not include a washer, as claimed, attention is again directed to Fritz which discloses a washer 16. Therefore, in further consideration of Fritz, it would have been obvious to one of ordinary skill in the overflow assembly art to associate a washer with the upper end of the Gebert overflow assembly in order to provide a better seal.

Applicant argues at pages 10-11 of the response filed December 11, 2009 the adapter ring 10 of Gebert does not meet the requirements of claims 11 and 21. The examiner disagrees. The nut element 8 in Gebert can be portrayed as "comprising a plurality of lugs (11) extending radially from said nut element" (language of claim 21, numeral from Gebert added). Indeed, the nut element 8 and ring 10 of Gebert cooperate "to secure said the overflow pipe to the end of the bathtub" as also recited in claim 21. Claim 11 is similarly worded. When giving the claims

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a reasonably broad interpretation as is required (MPEP 2111), the examiner finds that the noted claim language is met by the Gebert overflow assembly, because the claim language does not require a single-piece nut and lug(s) as implied by argument. Indeed, applicant is free during examination to amend the claims to positively recite structure commensurate in scope with argument. Applicant's argument is unpersuasive. Applicant argues at page 11 of the response the Gebert overflow assembly may be viewed as difficult to install. However, absent any correlation between this observation and the claimed subject matter, the examiner refrains from comment thereon at this time. Applicant argues at pages 11-12 of the response the Gebert disclosure does not enable a nut element comprising a plurality of radially extending lugs as recited in claim 21. The examiner disagrees. Given the teaching in Gebert of providing notches in the ring 10 to receive corresponding inner projections of the cap. In the examiner's opinion, one skilled in the art would have little, if any, difficulty in understanding this disclosure and would know how to both form notches in the ring and form projections on the cap. Applicant's argument is unpersuasive. Applicant argues at pages 2-5 of the response filed April 05, 2010 the Fritz reference should be removed as prior art relative to the instant application in light of the Rule 131 declarations

filed June 09, 2009. The examiner disagrees. The declarations of Bill Carlson and William T. Ball have been fully considered, but are not supported by sufficient facts to establish conception of the claimed invention prior to the effective date of the Fritz disclosure. Both of the noted declarations rely upon the same engineering drawings, denoted Exhibits A and B, as factual evidence of conception. However, neither of the exhibits appear to depict "a plurality of lugs" as recited in claim 21. Moreover, neither of the exhibits show possession of the "method" recited in claim 11. The examiner does acknowledge that the drawing labeled "WATCO OVERFLOW ELBOW PROTOTYPE" and designated "Fig. 4", as found in Exhibit B (last page), discloses an overflow pipe with a membrane. But, the date on that drawing is "2/9/2000" which is later than the December 01, 1999 filing date of Fritz. Therefore, the declarations do not factually establish conception of either of the claimed inventions. See MPEP 715.02 and 715.07. Applicant's explanation at page 3 of the response - that the noted membrane is also shown in the Exhibit A drawings - is not clearly established by either the drawing figures or the declarations. First of all, it would appear that if certain of the figures of Exhibit A (reproduced at page 3) were intended to evidence the presence of a "membrane", the illustrated subject matter would

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be referred to as such in the declarations. This would clarify any confusion resulting from a consideration of the other drawing figures associated with Exhibit A. In this regard, some of the other drawing figures are side views, and no membrane or diaphragm is apparently depicted therein. Still further, the "0.009 FLASHING" designation in the "Front View" at page 3 of the response might be equated with the drawing figures associated with Exhibit B and denoted "WOODFORD PART #1 2/14/00", where a similar designation "0.009 SOLID MEMBRANE" is illustrated. However, this correspondence of features is not referred to in the declarations, and, the Woodford 2/14/00 figures are not initialed by declarant Carlson consistent with the discussion in his declaration (par. 6). This potential confusion could easily be clarified by the declarant, and it would appear prudent to do so during prosecution. Secondly, the statement in paragraph 7 of the Carlson declaration that "Mr. Ball must have disclosed the invention to me at least in November of 1999" is considered to be a conclusion rather than a fact. Here, the declarant stated in the same paragraph that "it usually takes me about three to four weeks to perform modeling and drafting activities associated with a conceptual design." This statement does not refer to the attached drawing figures, and appears consistent with the model discussed at paragraph 5



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of the declaration where only "a threaded elbow, a wheel or flange nut and a cover plate" are specified. Again, this potential confusion could easily be clarified by the declarant. Lastly, the case law citations relied upon at pages 4-5 of the response have been reviewed. The examiner did not find any inconsistency between the analysis of the declaration evidence *supra*, and the noted case law. Generally, all of the cases cited relate to corroborative evidence. Of particular interest, the Price v. Symsek case (pgs. 1036/1038) involved effective corroboration where a declarant made specific reference to attached drawings as evidence.

4. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Fritz as applied to claims 11 and 12 above, and further in view of Ball '241.

Re claim 13, Ball '241 teaches the obvious use of a cutting instrument to remove an overflow testing diaphragm (col. 3 lns. 2-5). Re claim 15, Ball '241 further teaches the common provision of an interconnecting pipe 42 and vent pipe 40 (Fig. 2) associated with an overflow assembly.

Applicant has not substantively argued this ground of rejection beyond relying upon Fritz being removed as prior art.

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5. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Fritz as applied to claim 11 above, and further in view of Ball '931 and Ball '241.

Although the Gebert bathtub plumbing system may not include a drain pipe, lock washer and drain closure, as claimed, attention is directed to the Ball '931 reference which discloses an analogous bathtub plumbing system which further includes a drain pipe, lock washer and drain closure (col. 1 lns. 8-24). Therefore, in consideration of Ball '931, it would have been obvious to one of ordinary skill in the bathtub plumbing system art to associate a drain pipe, lock washer and drain closure with the Gebert bathtub plumbing system as being a common type of bathtub plumbing system. Furthermore, Ball '241 teaches plugging the drain port of a bathtub plumbing system during hydraulic testing "in any convenient manner" (col. 2 lns. 59-60), and further teaches use of a diaphragm 64 to accomplish such plugging (col. 2 lns. 37-40 and col. 2 ln. 65 thru col. 3 ln. 13).

Applicant has not substantively argued this ground of rejection beyond relying upon Fritz being removed as prior art.

6. Claims 11-13, 15, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Ball '241.

Gebert teaches all elements set forth in claim 21, as discussed supra, except for the provision of fluid flow preventing means (a plug). The Ball '241 reference teaches (cols. 2-3) a method of testing a plumbing system where an overflow pipe is plugged with a diaphragm 64, the system is tested, and then the overflow pipe is unplugged by cutting the diaphragm. It would have been obvious to one of ordinary skill in the art to perform a plumbing test, as taught by Ball '241, on the Gebert plumbing system, in order to determine system integrity.

Re claim 15, Ball '241 also teaches (Fig. 2) that a conventional plumbing system of the type disclosed by Gebert often includes a vent pipe 40 and interconnecting pipe 42.

7. Claims 11-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Ball '241 as applied to claims 11 and 21 above, and further in view of Espey et al. and Holt et al.

Re claim 21, the decorative cap 14 of Gebert is not connected directly to the nut 8. However, attention is directed to the Espey et al. (Espey) reference which teaches that a decorative cap is often provided to enhance the decorative appearance of a nut (col. 1 lns. 14-16). Moreover, Espey teaches a direct connection between the cap 40 and nut 20 via a

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plurality of lugs 34. It would have been obvious to one of ordinary skill in the art to connect the cap of Gebert directly to the nut as being an art recognized equivalent connection scheme to the retaining ring 10 securement scheme in Gebert. The Holt et al. (Holt) reference is cited here as evidence that an overflow cover of the type disclosed by Gebert does function for appearance purposes. See Holt at column 1, lines 46-52.

Re claim 23, Gebert further comprises a washer 10.

8. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Ball '241, taken either with or without Espey, as applied to claim 11 above, and further in view of Ball '931.

To associate a drain pipe, lock washer and drain closure with the Gebert bathtub plumbing system would have been obvious to one of ordinary skill in the art in consideration of Ball '931 analogous to the discussion supra.

To utilize a diaphragm to plug the drain port of the drain pipe would have been obvious to one of ordinary skill in the art in consideration of Ball '241 analogous to the discussion supra.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

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identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 21 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are anticipated by the patented claim, and anticipation is the epitome of obviousness.

11. Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Gebert. Gebert teaches use of a washer 10 placed between a bathtub wall 7 and an overflow nut element 8.

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12. Claims 11-13, 15 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241. Ball '241 teaches a method of testing a plumbing system where an overflow pipe is plugged with a diaphragm 64, the system is tested, and then the overflow pipe is unplugged by cutting the diaphragm. Ball '241 further teaches (Fig. 2) that a conventional plumbing system of the type recited in the patented claim often includes a vent pipe 40 and interconnecting pipe 42.

13. Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241 and Gebert. Ball '241 and Gebert teach the subject matter missing from the patented claim, as noted above.

14. Claims 16-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,675,406 in view of Ball '241 and Ball '931. Ball '241 teaches the testing method as noted above. Ball '931 teaches a drain pipe, lock washer and drain closure associated with an overflow assembly.

15. Applicant's remarks of December 11, 2009 and April 05, 2010 have been fully considered and have been previously addressed. Concerning applicant's repeated request for an indication of

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allowable subject matter, and a resolution to the long pendency of the instant application, the examiner notes parent applications 10/229,533 and 09/954,420 matured into patents 6,675,406 and 6,691,411, dated January 2004 and February 2004, respectively. This child application has been pursuing claims which are broader in scope than those previously patented. At this time, the examiner has no suggestions as to potential patentability of the broader claimed subject matter.

16. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

17. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

/Robert M. Fetsuga/  
Robert M. Fetsuga  
Primary Examiner  
Art Unit 3751